

REMARKS/ARGUMENTS

A. Objections

Claims 24-26 were objected to because of informalities and have been amended as appropriate.

B. Rejection of Claim 1 under 35 U.S.C. § 102(b)

Claim 1 was rejected under 35 U.S.C. 102(b) as being allegedly anticipated by Sharp (SID Symposium article). In response, the Applicant has amended claim 1 to clarify that “the optical filter is configured for vision,” as also recited in the preamble.

C. Rejection of Claims 2-3, 10-11, 16-26, 28-30, 32-34 under § 103 by Sharp in view of Land and Ogle

Claims 2-3, 10-11, 16-26, 28-30, and 32-34 were rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Sharp (SID Symposium article) in view of Land (US 2,184,999) and Ogle (US 4,595,262). The Applicant respectfully asserts that claims 2-3, 10-11, 16-26, 28-30, and 32-34 are not obvious over the cited references.

Numerous decisions emphasize that such a combination of reference teachings is improper unless the prior art suggests such a combination. See, e.g., *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990) (the PTO erred in rejecting the claimed invention as an obvious combination of the teachings of two prior art references when the prior art provided no teaching, suggestion or incentive supporting the combination); *SmithKline diagnostics, Inc. v. Helena Laboratories Corp.*, 859 F.2d 878, 887, 8 USPQ2d 1468, 1475 (Fed. Cir. 1988) (a challenger to the validity of a patent "cannot pick and choose among the individual elements of assorted prior art references to recreate the claimed invention."); the challenger "has the burden to

show some teaching or suggestion in the references to support their use in the particular claimed combination."); *Elf Antochem North America, Inc. v. Laroche Industries, Inc.*, 85 F. Supp.2d 336, 343 (D. Del. 2000) ("Two or more prior art references may be combined to demonstrate obviousness, but the prior art must provide a suggestion or motivation to combine the references.").

In accordance with this established case law, the references are not properly combinable in an attempt to arrive at the present claims. Support for this position is that Sharp, Land and Ogle provide entirely disparate teachings that are directed towards solving completely different and unrelated problems. Although the Examiner argues that there is motivation to combine these references because of the "increased flexibility in the design of a compact filter that can be used in conjunction with appropriate goggles to protect or selectively enhance human vision," the Applicant respectfully asserts that such an approach is not a proper test for finding motivation to combine references. Similarly, the alternative motivation to combine posited in the Office Action, that "such [a] filter would improve the vision of an observer exposed to an environment with varying lighting conditions; [and that] appropriate design of the polarizer/retarders/analyizer produces an output spectrum to the observer's eye that best fits (and compensates) for the exterior lighting conditions," fails to provide a *prima facie* motivation to combine the cited references. Simply identifying that teachings in one reference will benefit the system in another reference does not identify a motivation in one reference that would lead someone skilled in the pertinent field of art to seek out and combine the teachings of another reference.

As stated, in the proposed combination, each reference is directed to solving an entirely different problem. Furthermore, each reference addresses the respective problem in a

very different way. Specifically, although the Sharp reference refers to Retarder Stack Technology for Color Manipulation (*Sharp*, title), there is no teaching or suggestion whatsoever in Sharp of a filter configured *for vision*. The Sharp reference was presented to the Society for Information Display, and the reference proposes the use of FIR filters in the context of LCD-based projectors. *Sharp*, p.3. Accordingly, the filters discussed in the Sharp reference are far removed from teaching or suggesting a configuration for vision.

Ogle is directed to the use of goggles with a birefringent tunable filter to filter out a single selected wavelength from a variable wavelength laser, and proposes the use of a sequential disposition of various retardation plates with a rotatable analyzer for tuning the wavelength to address that problem. However, there is nothing in Ogle to suggest that color manipulation is even a concern, and in fact Ogle seems quite pleased with the filtering of a single tunable wavelength of laser light. The Examiner has cited Ogle for the proposition that numerous retarder *plates* can be stacked, yet the purpose of stacking retarder plates (e.g., *Ogle*, elements 12, 13, 14 of FIG. 1) has nothing to do with color manipulation -- it is simply to make the filter tunable to a selected wavelength. Notably, Applicant respectfully submits that the Ogle filter provides a completely deficient performance characteristic for color manipulation since the Ogle filter has sinusoidal filtering characteristics that, at best, provides an impulse response of a single retarder, therefore providing an extremely poor color quality. Accordingly, the steep transition slopes that may be provided by the claimed filters are simply not achievable using the teachings of Ogle. Furthermore, the recited claims provide retarder stacks comprising retarder *films*, not plates.

Land is directed towards a photographic filter, and proposes a filter employing principles of polarization interference (products of sinusoids) to compensate for the non-uniformity of sensitivity of ordinary photographic emulsion. *Land*, col. 2, lns. 43-48. By stacking the Land filters, Applicant respectfully submits that a polarization interference filter will result that cannot provide spectral characteristics of an optical filter for vision as the recited claims provide. Instead, a filter having, for example, the spectral distribution shown in *Land*, FIG. 7 will result. Since Land's compound filter is entirely different in structure, operation and spectral performance from Applicant's retarder stack filter, Applicant respectfully submits that Land fails to serve any purpose as a reference. Applicant also notes that there is nothing in Land to suggest configuring the Land filter for vision, or for that matter, color manipulation or improvement of vision.

For the foregoing reasons, one skilled in the art would not be motivated by anything taught by Ogle to suddenly feel the need to seek out and employ not only a new filter, but specifically an optical filter comprising ... a retarder stack comprising $N \geq 2$ retarder films ... wherein the optical filter is configured for vision. Likewise, one skilled in the art would not be motivated by anything in Land to all of a sudden seek out and employ a different filter, let alone the specific optical filter comprising ... a retarder stack comprising $N \geq 2$ retarder films taught by Sharp. In short, there is no motivation in either of these references that would cause one skilled in the art to be motivated to seek out and combine the teachings of the other reference. As a result, since these references are not properly combinable, the Applicant asserts that they do not form a proper basis for an obviousness rejection of claims 2-3, 10-11, 16-26, 28-30, and 32-34. Accordingly, the Applicant respectfully requests that this rejection be withdrawn.

D. Rejection of Claims 4-9 under § 103 by Sharp in view of Thornton

Claims 4-9 were rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Sharp (SID Symposium article) in view of Thornton (US 4,826,286). As claims 4-9 are dependent claims based upon independent claim 1, which is believed to be allowable, Applicant respectfully submits that claims 4-9 are allowable because they further limit claim 1. The following arguments concerning the inapplicability of the reference and lack of motivation to combine Thornton are also applicable to claims 4-9 and are incorporated by reference.

E. Rejection of Claims 12-15, 27, 31, and 37-53 under § 103 by Sharp in view of Land and Ogle and further in view of Thornton

Claims 12-15, 27, 31, and 37-53 were rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Sharp (SID Symposium article) in view of Land and Ogle and further in view of Thornton. As previously discussed, Applicant respectfully asserts that Sharp, Land, and Ogle are not properly combinable. There is nothing in the Thornton reference to provide the required motivation to combine the four references, so for similar reasons, the four-way combination of references are not properly combinable.

Specifically, Thornton teaches an absorptive filter, which is an entirely different type of filter to the FIR filter taught in the Sharp reference:

As to the form of the filter, a transparent substrate may have deposited on it a plurality of absorbing layers (for example, paints or dyes) that in aggregate transmit only the desired bands. Or the absorbing means may reside in a single layer on the transparent substrate. Alternatively, the absorbing media may be incorporated directly in the filter material, in which case there would be no transparent substrate.
Rather than using absorbing means, a plurality of

Thornton, col. 6, lns 26-34. The present Application recognized the absorptive filters disclosed in Thornton and their relative performance limitations by discussing them in the background

section, and distinguishing from them by teaching a completely different filter technology for vision. It is notable that Thornton doesn't teach or even recognize the use of polarization interference to accomplish filtering of the interprimary bands. Land teaches a filter for photography, which uses polarization interference in compound filter configurations to provide products of sinusoids (*see, e.g., Land*, FIG. 7) that compensate for the non-uniformity of sensitivity of ordinary photographic emulsion. *Land*, col. 2, lns. 43-48. Ogle teaches yet another filter technology providing a tunable birefringent filter built into safety goggles to selectively filter a single wavelength to protect vision from the selected wavelength of laser light. *Ogle*, abstract. The Sharp reference, on the other hand, proposes the use of FIR filters for use in LCD-based projection. *Sharp*, p.3. Picking and choosing isolated elements from each of these disparate references to provide a piecemeal combination of the recited claim limitations fails to meet the long-established tests for obviousness set out above. Accordingly, with each reference addressing a different problem, and providing different solutions to those problems, a person of ordinary skill in the art would not be motivated to combine all four references to teach or suggest the limitations recited in independent claims 12, 37, and 42.

Since dependent claims 13-15, 27, 31, 38-41, and 43-53 are dependent upon respective independent claims 12, 37, and 42, Applicant respectfully submits that they are allowable for similar reasons because they further limit the respective independent claims.

F. Conclusion

Applicant respectfully submits that all pending claims are in condition for allowance, and request a Notice of Allowability for the pending claims. The Examiner is invited to contact the undersigned Attorney if such would expedite the prosecution of the present Application. The three-month response deadline is set to expire on July 25, 2006. As a result,

no extension fee is believed due with this filing. However, if a fee is determined to be due, Applicant hereby authorizes the Commissioner to charge the necessary amount to Deposit Account No. 13-0480, referencing the Attorney Docket Number specified herein.

Respectfully submitted,

/Neil G. J. Mothew/

Date: June 26, 2006

Neil G. J. Mothew
Reg. No. 54,922

BAKER & MCKENZIE LLP
2300 Trammell Crow Center
2001 Ross Avenue
Dallas, TX 75201
Tel: (214) 978-3077
Fax: (214) 978-3099

Neil.G.Mothew@bakernet.com